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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,706	06/21/1999	SUMIYO OKADA	21.1924/JRB	7969

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WASHINGTON, DC 20005

EXAMINER
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PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 01/12/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/336,706

Applicant(s)

OKADA, SUMIYO ET. AL.

Examiner

B. Prieto

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 13-25 is/are pending in the application.
- 4a) Of the above claim(s) 13-15, and 18-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### ***Detailed Action***

1. This communication is in response to election filed 11/04/03, claims 1-3 and 13-25 are now pending, claims 4-12 were previously cancelled and 23-25 were newly added.
2. Applicant's election of Group II (claim 2) and traversal is acknowledged. Claim 1 has been amended to obviate restriction and define substantially the same essential characteristics as claim 2, as noted by applicant. Claim 3 has been amended to depend on claim 2. Further, applicant indicates that claims 13-15 have also been amended by deleting a feature for the purpose of having the claim included with the group of claim 2. However, the feature applicant indicated he deleted, was in fact added as a dependent feature of claims 13-15, specifically, as newly added claims 23, 24 and 25.
3. Applicant traverse the grouping of claim 18 indicating that claim 18 cannot have a separate utility from groups I, II and IV, because the displaying feature of claim 18 is not substantially different from the displaying feature recited in groups I, II and IV. Applicant's argument has been noted, however, claim 18 requires displaying in a discrete display area of the client, messages received by the chat client from the first chat channel of a first chat network and a second chat channel of a second chat network, these features are distinct from groups I, II and IV. Restriction is sustained.
4. Claims 1-3 and 16-17 have been examined, claims 4-12 were cancelled, and claims 13-15, 18-25 are withdrawn from consideration.
5. Claim 1 recites the clause "designating with the client" in line 4 and 6 of the claim and further the clause "the plurality of chat networks" in the last line of the claim. There is insufficient antecedent basis for these limitations in the claim.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-3 and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Redpath et. al. U.S. Patent No. 5,990,887 (Redpath hereafter)

Regarding claim 2, Redpath teach substantial features of the invention as claimed, teaching ("information exchange") system in which user terminals (12/30 of Fig. 1 or 110/100 of Fig. 2) are configured for connection to a plurality of network communication sessions ("chat networks") to transmit and receive messages through the plurality of chat networks (col 3/lines 3-13, 38-41 and 49), the user terminals having a ("message display") area (Fig. 3) for displaying messages transmitted (Fig. 6A, elements 602, 608, 616, 622) and received (Fig. 6A, elements 604, 606) to or from each of the plurality of chat networks (col 3/lines 14-32), the information exchange system comprising:

designation means (100 of Fig. 2) ("designating") establishing a ("chat network") network communication or session of the plurality of chat networks as an ("active chat network") current network communication or session for receiving messages transmitted by a user terminal (col 3/lines 3-13 and Fig. 2); and

message acquiring means (100 of Fig. 2) of the user terminal for acquiring messages transmitted and received to or from each the plurality of chat networks (col 3/lines 3-13 and col 4/lines 37 to col 5/line 12); and

message displaying means (100 of Fig. 2 and Figs. 3 and 6) of the user terminal for displaying the acquired messages in a ("discrete display") area independent of a ("message display") area of each of the plurality of chat networks (col 4/lines 37-col 5/line12 and 3/lines 3-13).

Regarding claim 1, Redpath teaches a method including a ("chat client") user's terminal (100 or 110 of Fig. 2) in a ("information exchange") system (8 of Fig. 1) (abstract) for transmitting and receiving messages (col 1/lines 15-20, and col 2/lines 20-26) through two ("chat networks") communication means to transmit and receive the messages by the terminal (col 3/lines 3-13 and Fig. 2), the system comprising:

designation means (100 of Fig. 2) designating at a chat network of the plurality of chat network as an active chat network for receiving messages transmitted by a user terminal (col 3/lines 3-13 and Fig. 2); and

obtaining with the user terminal (100/110 of Fig. 2) the messages at least some of which are transmitted to or received from one of the chat networks and at least some of which are transmitted to or received from another of the chat networks (col 3/lines 3-32, Figs. 6A-C); and

displaying with the user's terminal the obtained messages transmitted to the two chat networks in ("first discrete display") an area independent of a message display area of each the two chat networks (602, 608, 616, 622 of Fig. 6A, col 3/lines 3-32 and col 4/line 37 to col 5/line 12).

Regarding claim 3, message transmission cooperating means (100/110 of Fig. 2) of the user terminal for transmitting a message when the messaged edited and displayed on a designated area independent from the other designated areas on the screen is identified for transmission by pressing the enter causing the displayed message displayed on a designated area to be transmitted to recipient on at least one of the plurality of network (col 4/lines 36-col 5/line 12).

Regarding claim 16, displaying messages of both chat networks in independent areas (602, 608, 616, 622 of Fig. 6a, col 3/lines 3-32 and 4/line 37-col 5/line 12).

Regarding claim 17, ("discrete display") area is separate from another display area that is dedicated to the ("active chat") network communication (col 4/lines 37-col 5/line12 and 3/lines 3-13 of Figs. 3 and 6).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231


or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided stamped "TC 2100".

  
B. Prieto  
Patent Examiner